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OFFICE OF PETITIONS

In re Reissue Application of :
Richard A. Becker et al. : DECISION
Application No.: 08/285,363 : TERMINATING
Filed: August 3, 1994 : REISSUE PROCEEDING
Attorney Docket No.: 129250-000947/US :

This is a decision terminating the instant reissue proceeding based on the expiration of U.S. patent 5,136,690, for which patent the present application requests reissue.

BACKGROUND

1. Application number 07/672,740 ("the '740 application") was filed on March 21, 1991, pursuant to the provisions of 35 U.S.C. § 111.
2. The '740 application was allowed on January 28, 1992, and issued as U.S. Patent No. 5,136,690 ("the '690 patent") on August 4, 1992.
3. The '740 application and resulting '690 patent claimed benefit under 35 U.S.C. § 120 of application Ser. No. 07/390,550 ("the '550 application") filed on August 7, 1989.
4. Reissue application No. 08/285,363 ("the '363 reissue application") was filed on August 3, 1994, for reissue of the '690 patent.
5. The Image File Wrapper (IFW) record for the '363 reissue application reveals that the prosecution of the application is not closed.

STATUTES AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 251, first paragraph, provides that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent

for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

35 U.S.C. §§ 154(a)(2) and (a)(3) provide that:

(2) TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

(3) PRIORITY.—Priority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent.

35 U.S.C. § 154(c)(1) states:

DETERMINATION.—The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

MPEP § 2701 states, in pertinent part,

All patents (other than design patents) that were in force on June 8, 1995, or that issued on an application that was filed before June 8, 1995, have a term that is the greater of the "twenty-year term" or seventeen years from the patent grant. See 35 U.S.C. 154(c).

DECISION

As pointed out above, the '690 patent issued from the '740 application. The '740 application and '690 patent claim benefit under 35 U.S.C. § 120 of the '550 application filed on August 7, 1989. The '690 patent is a patent that was in force on June 8, 1995. Therefore, the term of the '690 patent is the greater of seventeen years from its issue date of August 4, 1992, or twenty years from the August 7, 1989 filing date of the '550 application, from which the '740 application that matured into the '690 patent claims benefit.

The '690 patent term, as calculated by using seventeen years from the issue date of August 4, 1992, extends through August 4, 2009. The '690 patent term, as calculated by using twenty years from the August 7, 1989 filing date of the '550 application, extends through August 7, 2009. In accordance with 35 U.S.C. § 154(c)(1) and the discussion in MPEP § 2701, the term of the '690 patent is the longer term, *i.e.*, twenty years measured from the August 7, 1989 filing date of the '550 application. Thus, the patent expired after August 7, 2009.

The United States Court of Appeals for the Federal Circuit has stated:

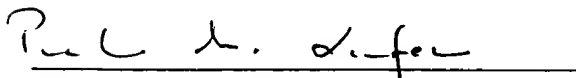
"[t]he language of [35 U.S.C. §] 251 is unambiguous: the [Director] has authority to reissue a patent only for the unexpired term of the original patent." (Emphasis the Court's.)

In re Morgan, 990 F.2d 1230, 1231, 26 USPQ2d 1363, 1393 (Fed. Cir. 1993) (quoting 35 U.S.C. § 251, ¶ 1). Therefore, assuming (*arguendo*) that the conditions of 35 U.S.C. § 251 were otherwise satisfied, the USPTO Director had the authority to reissue the '690 patent only for a term that expired on August 7, 2009, in accordance with 35 U.S.C. § 251, ¶ 1 ("the Director shall . . . reissue the patent . . . for the unexpired part of the term of the original patent.").

Because the '690 patent is now an expired patent, the Director no longer has the authority under 35 U.S.C. § 251 to reissue the '690 patent. *In re Morgan*, 990 F.2d at 1231, 26 USPQ2d at 1393.

CONCLUSION

1. In view of the above, the '363 reissue application is hereby terminated. See *Morgan*, 990 F.2d at 1232, 26 USPQ2d at 1393 (while 35 U.S.C. § 251 does not expressly state a requirement for termination of a reissue proceeding when a patent expires, that is an inevitable concomitant of the provision that the patent can no longer be reissued).
2. This decision is not a final agency action within the meaning of 5 U.S.C. § 704. Any request for further review of this matter must be by way of a petition under 37 CFR 1.181(a)(3) filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b).
3. Jurisdiction over the '363 reissue application is being retained by the Office of Patent Legal Administration for the two months in which any request for further review may be submitted (plus time to match any such request). At that time, if no persuasive request is received, the application will be forwarded to Technology Center Art Unit 2628 for processing as an abandoned application.
4. Telephone inquiries concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.



Pinchus M. Laufer

Legal Advisor

Office of Patent Legal Administration

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